01702.401600

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
GUSTAV GAUDERNACK, ET AL.
Application No.: 09/674,913
Int'l Appl. No.: PCT/NO99/00141
Natl. Entry: November 8, 2000
For: FRAMESHIFT MUTANTS OF BETA-AMYLOID PRECURSOR PROTEIN AND UBIQUITIN-B AND THEIR USE

Examiner: Christopher Nichols, Ph.D.
Group Art Unit: 1647

October 15, 2002

Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the restriction requirement made in the Office Action mailed September 18, 2002, regarding this patent application, Applicant hereby elects the invention of Group I and the amino acid sequence identified as SEQ ID NO. 2, but with traversal.

The Group I claims (Nos. 27-37) are directed to the elected peptide SEQ ID NO. 2, which can be used to induce an immunogenic response against cells that produce aberrant proteins resulting from frameshift mutations associated with Alzheimer's disease and Down syndrome. Claim 37 is directed to a pharmaceutical composition containing the elected peptide and a pharmaceutically acceptable carrier or diluent.

The Group III claims (Nos. 39-43) are directed to a method of treating a human patient for the prophylaxis or treatment of Alzheimer's disease or Down's syndrome that involves administering the elected SEQ ID NO. 2 peptide.

Essentially, then, the claims of Group I are directed to a product, and the claims of Group III are directed to a method of using that product. All of the claims focus on the elected SEQ ID NO. 2 peptide.

As set forth in Paragraph 802.01 of the Manual of Patent Examining Procedure, restriction is proper only if two or more "independent and distinct" inventions are claimed in one application. A product and a process of using the product are not "distinct" unless they are "capable of separate manufacture, use, or sale as claimed." Id. The products and processes to which the Group I and Group III claims of this application are directed do not meet that test. The claimed process cannot be practiced without using the claimed product.

Moreover, the search and examination of both groups of claims (I and III) can be made without serious burden, given their common focus on one thing: the SEQ ID NO. 2 peptide. Accordingly, even if it were concluded that independent and distinct inventions are being claimed (which is not the case), restriction still is improper between those two groups. See MPEP §803. ("If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.")

It is also respectfully submitted that it is not mandatory for the Examiner to make a restriction requirement in every possible situation. It is earnestly believed that examination of all of the claims in this application by one Examiner will best ensure that there will be uniform prosecution quality. Moreover, it is submitted that all of the claims can be searched by one Examiner without undue effort, and that a duplicative search by two Examiners may possibly produce inconsistent results. In addition, it is believed that if one Examiner acts on all the claims of the present application, overall examining time will be less than if two Examiners are involved. Applicant submits that this is especially true with respect to the peptides according to SEQ ID NO. 2 and SEQ ID NO.5, which are fragments of the same precursor protein, although representing different targets.

Therefore, in the interest of prosecution quality and economy for both the Office and Applicant, it is submitted that withdrawal of the restriction requirement in this application is appropriate. Accordingly, such action is respectfully solicited.

If the Examiner declines to withdraw the restriction requirement in its entirety, Applicant respectfully requests that Groups I and III be merged and that he be allowed to elect SEQ ID NO. 5 along with SEQ ID NO. 2.

No fee is believed due in connection with this paper; however, if any fee is due, it should be charged to Deposit Account No. 06-1205. A duplicate of this paper is enclosed for that purpose.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

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